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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,274	03/28/2001	Michael S. Brunner	KCX-196.1(15778.10)	1690

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/820,274

Applicant(s)

BRUNNER ET AL.

Examiner

Krishnan S Menon

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1,2,5-15,23,29-34 and 36-38

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Response to Arguments

Applicant's arguments filed 6/1/04 have been fully considered but they are not persuasive.

In response to applicants' argument re the Muramatsu ref that "This pre-coat layer of activated carbon powder particles is different from Applicants' claimed filter element that contain a particulate laminate having two or more layers of filter media. For instance, in some embodiments of Applicants' invention, this particulate Laminate may be a three-layered Laminate including a charge-modified layer laminated onto both the top and bottom of a Layer containing activated carbon. (See Appl. page 22, lines 1-11). Applicants respectfully submit that no such particulate laminate having two or more layers of filter media is taught by Muramatsu. et al.'s pre-coat Layer of activated carbon powder particles that may be formed over the surface of the filter membrane." : The element of the claim being argued about is 'second filter element contains a particulate laminate having two or more layer of filter media'. Muramatsu in fig 4 and 6 shows such a laminate: layer 18 is a net, layer 17 is a filter cloth and layer 37 is a layer of activated carbon. This would constitute "two or more layer of filter media", since each of these layers can be filter media: the net, the cloth and the activated carbon layer, because each of them individually could filter materials from a fluid stream. They are laminates, because the layers are bound together by mechanical (the result of the corrugation) or other means. [The dictionary meaning of laminate is 'consisting of laminae (layers)': Webster's Collegiate Dictionary, 10th Ed.]. The claims are open ended, and do not require that each of the layers have particulates. If the applicant is implying that the

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Applicants' laminate is made by a different process, that is not claimed, and also that is not patentable (see *In re Thorpe* on product by process claims). Re the motivation for combining the references, it is clearly stated in the rejection.

The other argument Applicants put forth is re the dimensions of the pleats, volume of the filter, etc., which were rejected on the grounds that they are optimizable by one of ordinary skill in the art. Applicants argue in this regard: "For instance, by using filter elements having different surface contact area, the filtration capabilities of each filter element may be optimized (Appl, p. 3, lines 18-24), while, overall, the particular dimensions of the pleats and the size of the filter elements may maximize the filtration properties of the filter without significantly increasing the cost or the size of the filter", thereby confirming that the sizes are a result of an optimization, and has no other structural or functional purpose. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Also please note: In *re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


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